REMARKS

Upon entry of the present amendment, claims 4-6, 9, 13, 15, 18-22, 25, 30-32, 35 and 46-70 will be pending in this application. Claims 4-6, 9, 13, 15, 18-22, 25, 30-32, 46, 47, 49, 51, 53-56, 59, 60, 62 and 65-67 are allowed. October 4, 2007 Office Action, page 1, paragraph 5 and page 3, paragraph 7.

Applicants' Assignee and the undersigned attorney thank the Examiner for his thorough consideration of the application and for allowance of claims 4-6, 9, 13, 15, 18-22, 25, 30-32, 46, 47, 49, 51, 53-56, 60 62 and 65-67. The claim incorrectly labeled "8" in the prior Amendment and Response (of December 17, 2007) has been corrected in accordance with the Examiner's suggestion to be labeled claim "9."

All of claims 35, 48, 50, 52, 57-58, 61, 63-64 and 68-70 stand rejected.

Claims 63 and 64

As noted in the prior Amendment and Response, Claims 64 depends from claim 63, which depends from **allowed** claim 62, which depends from **allowed** claim 4; accordingly it appears that claims 63 and 64 should have been allowed. Applicants' Assignee therefore requests reconsideration and allowance of Claims 63 and 64.

Claims 35, 48, 50, 52, 57-58, 61 and 68-70

Claims 35, 48, 50, 52, 57-58, 61 and 68-70 were rejected under 35 U.S.C. 103(a) as being unpatentable over McCubbin in view of Kelsey or over McCubbin in view of Kelsey and McLean.

As the Specification of the above-referenced application explains, the honing guide assembly of this invention is

> usable with a wide range of chisels and blade widths, thicknesses, lengths and end configurations (square or skewed) to hone a wide range of bevel angles. . . . A clamping bar contacting the face of the tool or blade adjacent to the bevel securely presses against a reference surface in the guide a surface of the tool or blade that intersects the bevel to form the cutting edge or arris. This reference surface is parallel to the roller axis of rotation.

Specification, p. 3, lines 3-12.

The application also explains the improved clamping bar structure of claim 35 that prevents the blade from shifting or skewing in the holder during use:

> The honing guide of this invention may also include concave surface clamp bars to improve the blade-holding ability of the assembly. The concave clamping surface of the clamp bar of this honing guide forces the separation of the regions of contact with the tool being honed and concentrates the clamping force along parallel lines.

Specification, p. 4, lines 23-27 (emphasis added).

The rejection of Claim 35 and the claims depending from it should be withdrawn for the reasons explained below. In order to expedite prosecution and in light of the apparent construction of Claim 35 applied for the first time in the March 31, 2008 Office Action, Claim 35 has been amended to emphasize the type of tool with which the holder and jig of that claim is used and to clarify the interaction between the tool and the Claim 35 holder.

The March 21, 2008 Office Action rejected Claims 35 and the claims depending from it, claims 48, 52 and 57-58, as follows:

> 5. Claims 35, 48, 52, and 57-58 are rejected under 35 U.S.C. 103(a) as being unpatentable over McCubbin in view of Kelsey. McCubbin discloses a tool honing guide and bevel setting jig for honing a tool comprising substantially all of the subject matter set forth in Applicant's claims above, except for the recitation of the tool clamping bars having a concave surface. Note guide(12) comprising tool holder(11,18) and roller(20); and jig(21') for removable coupling to the guide to set the tool at selective sharpening angles. The tool is secured in a guide by drawing a tool securing bar against the guide reference surface, and an adjustable stop(32) is used to establish the extent of projection of the tool from the guide for sharpening at the proper angle. To modify the tool in McCubbin by providing concave surfaces on the clamping bars, to provide plural parallel lines of contact to prevent shifting of the tool during use, would have been obvious in view of Kelsey.

March 21, 2008 Office Action at 2-3.

Applicants' assignee respectfully requests reconsideration of this rejection because: (1) modification of McCubbin to incorporate the tool jaw 7 of Kelsey would not result in a honing guide structure usable for the woodworking chisels and blades with which the present invention is used and (2) it is not in compliance with applicable MPEP instructions to Examiners about rejections under 35 U.S.C. 103(a) following the *KSR* case.

1. Combination of McCubbin and Kelsey Does Not Work

McCubbin discloses a tool holder (shown here in Figure 2 and 4) having a flat plate 18 that secures a blade 25 "such as a plane blade, chisel, or the like," McCubbin, col. 1, line 20, between the plate 18 and a "bight ll."

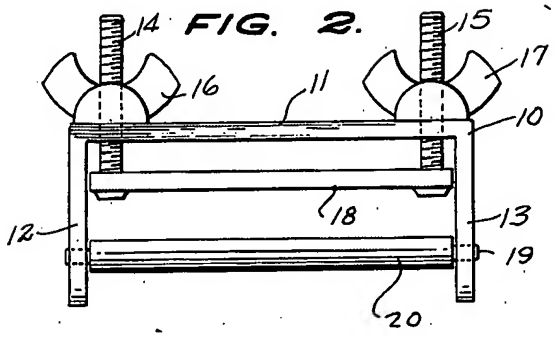


FIG. 2.

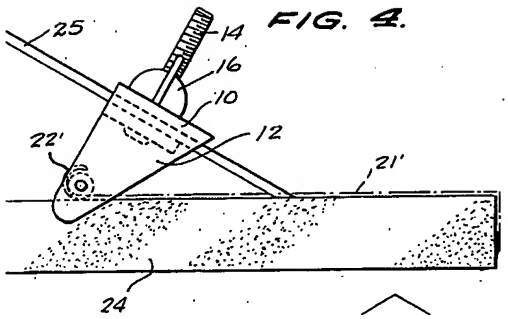


FIG. 4.

Kelsey discloses a dental tool holder for grinding the tips of dental tools. The dental tools with which Kelsey is used have small diameter round shanks in three different shapes. These shank shapes can be seen in Figures 5, 6 and 7 reproduced below. The dental tool shanks are captured between a fixed lower structure "connecting portion 3" of a "base 2" and an upper, movable jaw 7 that is lowered onto the dental tool "while allowing it to oscillate slightly and seat itself on the shanks of the tool." Kelsey, p. 1, lines 69-75. As can be seen in Figures 1 and 2 (reproduced below), the movable jaw 7 has three inverted, side by side, V-shaped grooves above a flat horizontal region of "connecting portion 3" at the front of the tool. The front is shown in Figure 2, in which the tip of the dental tool is the small square at the bottom of the drawing under the center inverted V-shaped groove in the jaw 7:

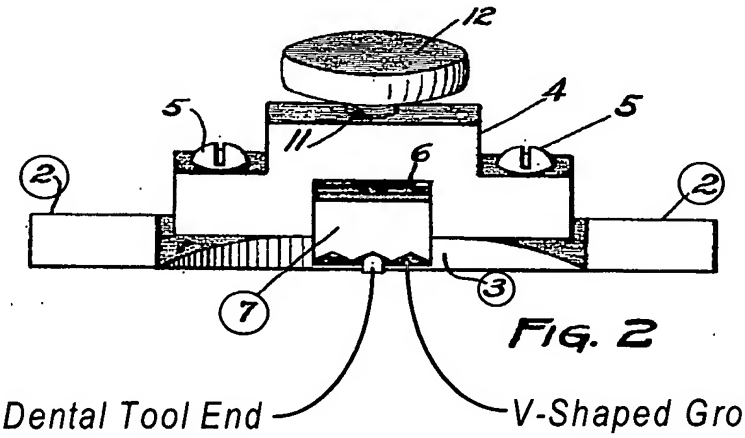


FIG. 2

The inverted V-shaped grooves are all inclined toward the rear of the tool, but by different amounts, so as to be positioned above three "stationary seats 14, 15 and 16 and upon these seats the shanks of differently shaped dental tools are placed." Kelsey, p. 1, lines 76-78. The stationary seats 14, 15 and 16 are marked in Figure 1 below, in which the cross section of the dental tool shank is the round solid dot between the seat 15 and the corresponding inverted V-shaped groove in jaw 7.

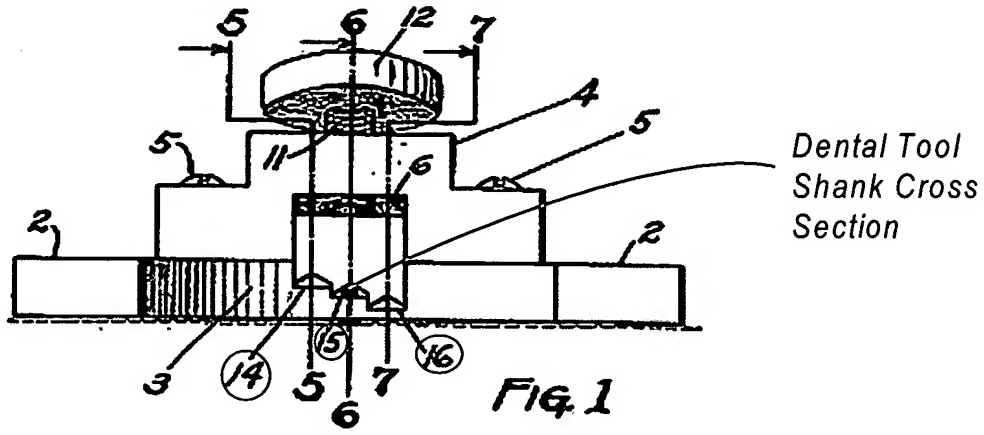


FIG. 1

Kelsey explains how dental tools are held at p. 1, lines 78-84, by reference to side views in section through the dental tools and the three holder structures that grasp the three different tools: "For instance, as shown in Figure 5, the seat 14 is adapted to receive a slightly curved shank on the tool,

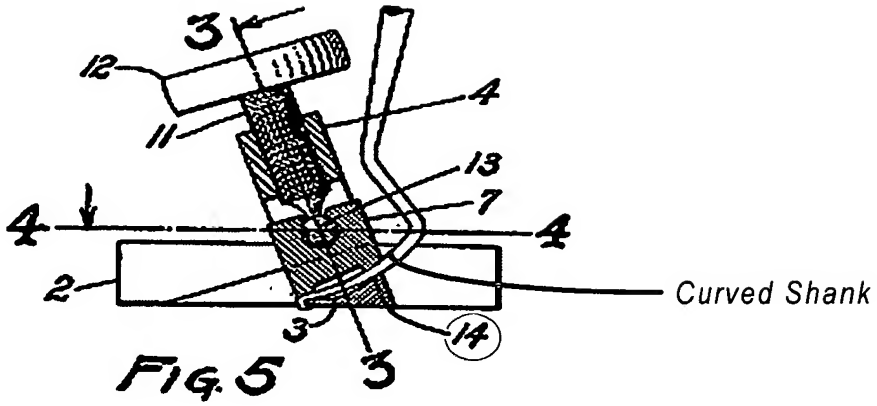


FIG. 5

while the seat 15, as shown in Figure 6, is adapted for a straight shank and

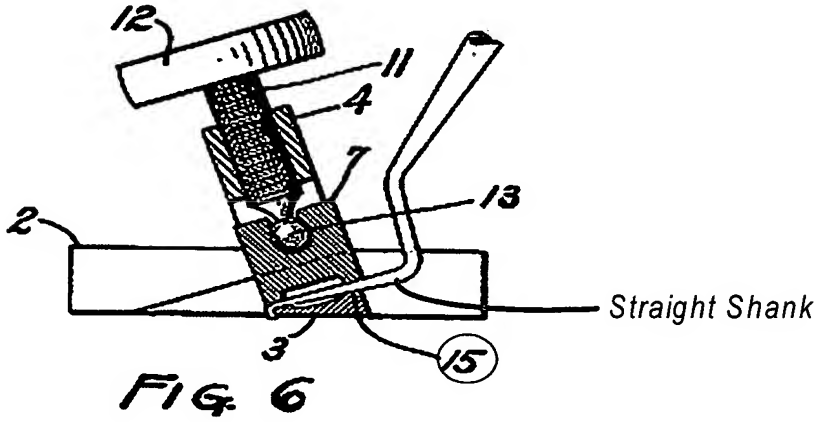


FIG. 6

the seat 16, as shown in Figure 7, receives a tool that is curved oppositely to the shank of Figure 5 . . . ."

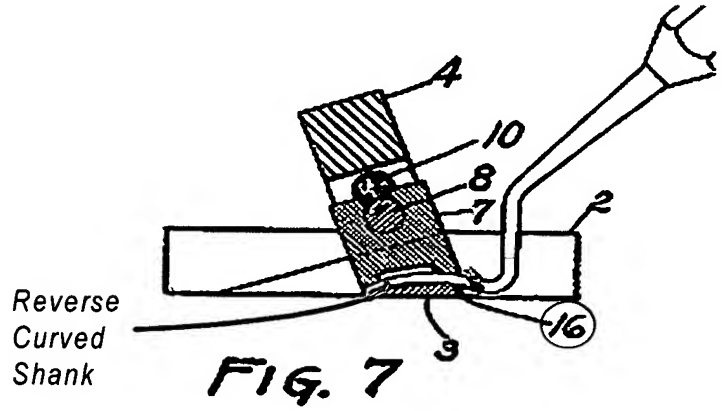


FIG. 7

Inspection of the Kelsey drawings and the following explanation from the Kelsey patent makes clear that the very specific Kelsey structure is provided in order to provide one tool holder that can accommodate three dental tools having differently shaped shanks:

> The movable jaw and the seats or stationary jaws are preferably formed, as shown in the sectional views, with bearing surfaces at the front and rear, while the middle portion is recessed or cut away, the forward portion of the stationary jaw being substantially the same for all the tools to receive the extremity of the shank and support the cutting edges of the tools in the same relative position with respect to the bottom of the holder and the grinding surface of the stone on which the tool is placed.
>
> The rear side of the holder shows the stationary jaw seats upon different levels to accommodate tool shanks of different shape, while the face or front of the holder shows the jaw seats upon the same level to support the cutting edges of the tools in the same relative position and insure uniform contact of said edges with the grinding surface.

Kelsey, p. 1, lines 8-108.

The small diameter, round dental tool shanks secured in the Kelsey tool holder cannot move laterally because they are trapped within the appropriate one of the three inverted V-shapes of jaw 7. This is well illustrated in Figure 1, showing the round dental tool shank (the round black dot above the seat 15) and the bent tool end, which is the square shape centered at the bottom of Figure 2:

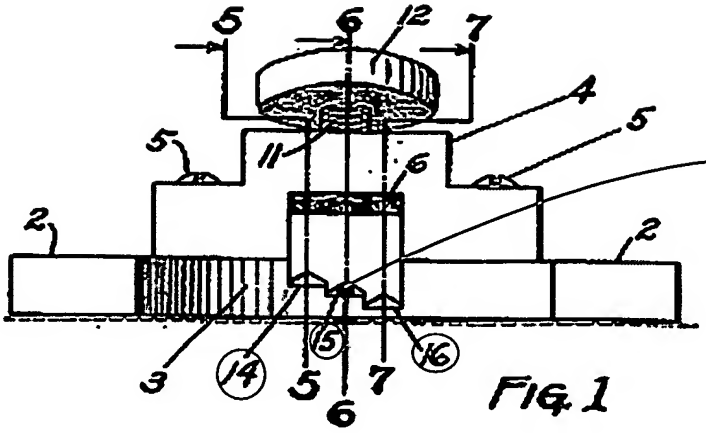


FIG. 1

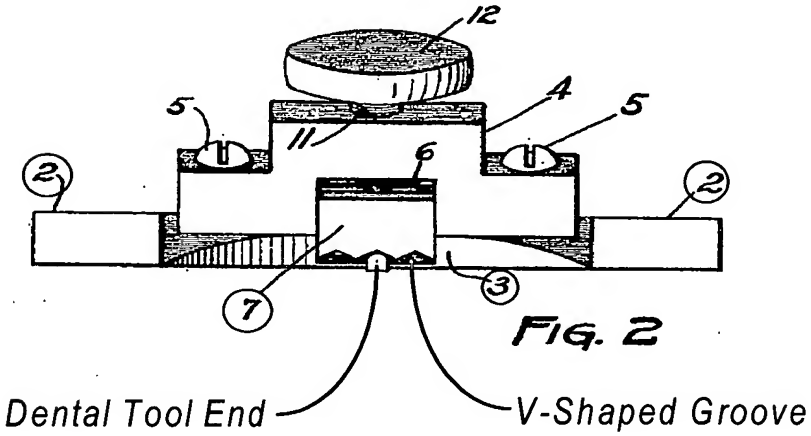


FIG. 2

Thus, it is not "plural parallel lines of contact" (as suggested by the Office Action) that prevents shifting of the Kelsey tool during use; it is the positioning of a V-shaped recess in Kelsey jaw 7 opposite a planar region in the Kelsey base 3. Thus, the lines of contact between the dental tool and Kelsey jaw 7 are transverse to (not parallel to) lines of contact between the dental tool and Kelsey base 3 seats 14, 15 and 16.

Nothing in Kelsey teaches or suggests that skewing of the tool in the Kelsey holder is prevented because there is contact between the movable jaw 7 and the dental tools held by the Kelsey tool holder only at the front (Figure 2) and rear (Figure 1) of the jaw 7. It is clear

such front and rear contact is not what prevents skewing of the tool in the Kelsey holder.

Skewing is prevented in the first instance because the small, round dental tool shank is trapped in the inverted V-shape in the jaw 7, and skewing plainly would be substantially prevented even before jaw 7 has closed far enough to force the tool shank against the seat 14, 15 or 16. The V-shape in jaw 7 plainly "traps" the dental tool before it presses it against the seat.

Moreover, there are at least three reasons that combination of Kelsey and McCubbin would not result in the structure of pending independent claim 35 and dependent claims 48, 52, 57-58, 61 and 68-70.

First, in order to combine Kelsey and McCubbin, one or the other of the two structures would have to be inverted. This is because in Kelsey the side of the dental tool facing the abrasive surface registers against an upward-facing flat surface of "the bottom of the holder" 3, but, by contrast, in McCubbin the flat registration surface ("bight 11") against which the tool is forced is downward-facing relative to the abrasive surface.

Second, if the Kelsey jaw 7 were used with the McCubbin tool and blade holder, the combination could only be used with small-cross-section shank tools small enough to fit within one of the Kelsey jaw 7 inverted V-shaped grooves, and it could not be used with the woodworking chisels and plane blades intended for use with McCubbin and the claimed invention of the present application.

Third, if the Kelsey jaw 7 were used, there would not necessarily be registration between the tool flat surface opposite the cutting edge bevel and a surface (the bight 11 in McCubbin) square to the roller (and, thus, the abrasive surface) during use of the honing

guide. Whatever small tools that could be fitted within the McCubbin/Kelsey device could easily rotate as they were secured by the moving jaw 7 with V-shaped recesses.

2. The 103(a) Rejections Do Not Comply With Controlling Guidelines

The U.S. Supreme Court ruled in *KSR International Co. v. Teleflex Inc.* ("KSR") April 30, 2007. Following that case, on October 10, 2007, the USPTO issued "Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in View of the Supreme Court Decision in KSR International Co. v. Teleflex Inc." (the "Guidelines"). Those Guidelines were incorporated into the current version of the MPEP, which is Rev. 6, Sept. 2007.

> As reiterated by the Supreme Court in *KSR*, the framework for the objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). Obviousness is a question of law based on underlying factual inquiries. The factual inquiries enunciated by the Court are as follows:
>
> (A) Ascertaining the differences between the claimed invention and the prior art (sic, should read: determining the scope and content of the prior art); and
> (B) Ascertaining the differences between the claimed invention and the prior art; and
> (C) Resolving the level of ordinary skill in the pertinent art.
>
> * * * * *
>
> When making an obviousness rejection, Office personnel must therefore ensure that the written record includes findings of fact concerning the state of the art and the teachings of the references applied. In certain circumstances, it may also be important to include explicit findings as to how a person of ordinary skill would have understood prior art teachings, or what a person of ordinary skill would have known or could have done. Factual findings made by Office personnel are the necessary underpinnings to establish obviousness. Once the findings of fact are articulated, **Office personnel must provide an explanation to support an obviousness rejection under 35 U.S.C. 103. 35 U.S.C. 132 requires that the applicant be notified of the reasons for the rejection of the claim so that he or she can decide how best to proceed**.

> Clearly setting forth findings of fact and the rationale(s) to support a rejection in an Office action leads to the prompt resolution of issues pertinent to patentability.

MPEP, 2141, p. 2100-118 (emphasis added).

The March 31, 2008 Office Action asserts that "to modify the tool in McCubbin by providing concave surfaces on the clamping bars, to provide plural parallel lines of contact to prevent shifting of the tool during use, would have been obvious in view of Kelsey." This is merely an assertion that Kelsey practices what the present patent application discloses to be desirable. The provision of "concave surfaces" and "plural parallel lines of contact" is described in the pending application, not in Kelsey. (See the quotation from the Specification reproduced on p. 10 above). Accordingly, the Office Action provides no explanation at all about why it would have been obvious to combine with McCubbin one purported element of the structure of Kelsey (the "concave surfaces) (but presumably not the V-shaped grooves of the Kelsey structure). The purported "concave surfaces" identified in Kelsey by the Office Action have no meaning in that patent without the instruction of the pending application. Applicants' Assignee and the undersigned attorney respectfully suggest that the combination of the Kelsey structure with McCubbin is a hindsight reconstruction, not a combination that would have obvious to those of ordinary skill in the art.

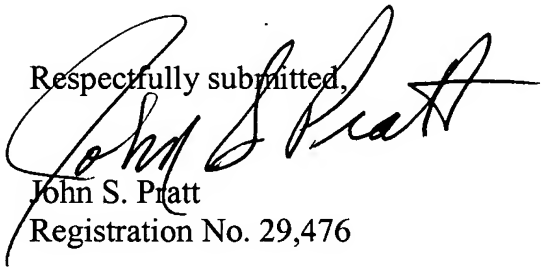
CONCLUSION

Accordingly, the rejection should be withdrawn, and claims 35, 48, 52 and 57-58, 61 and 68-70 should be allowed for at least the reasons identified above.

The amendments and the above remarks completely responded to the Office Action and place the application in condition for allowance. Such action is respectfully requested.

If the Examiner believes any informalities remain in the application that may be corrected by Examiner's Amendment, or there are any other issues that can be resolved by telephone interview, a telephone call to the undersigned attorney at (404) 815-6367 is respectfully solicited.

Respectfully submitted,



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